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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,133	09/09/2003	Homan B. Kinsley JR.	013400-200	1904
21839	7590	01/10/2005	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			HALPERN, MARK	
POST OFFICE BOX 1404			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22313-1404			1731	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/657,133	<b>Applicant(s)</b> KINSLEY, HOMAN B.	
	<b>Examiner</b> Mark Halpern	<b>Art Unit</b> 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-15 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/26/04</u> . | 6) <input type="checkbox"/> Other: ____.                                                |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 1-2, 10-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan (2,999,788). Morgan discloses a process of making a paper from a mixed slurry containing polyamide fibers and fibrils (cols. 37-38) deposited onto a moving wire, followed by drying and calendering in a calender consisting of a stack of rolls 24. The resulting sheet is glossy (col. 55, line 72 to col. 56, line 17, Figure 14, col. 26, lines 71-74.). Morgan is silent on shear being imparted on to the web by calender rolls operating at different speeds, however, it would have been obvious, to one skilled in the art at the time the invention was made, that at least two of the calender rolls of the

Morgan be operating at different at different speeds and provide shear onto the web, since the resulting product sheet is glossy.

2) Claims 3, 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan in view of Schonheit (5,060,565). Morgan is applied as per above for claims 1, 13, Morgan is silent on at least two of the calender rolls having different diameters.

Schonheit is disclosing a papermaking operation utilizing a calender wherein cylinders of different diameters are positioned next to each other (Abstract, Figures 1, 3). It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Morgan and Schonheit, because such a combination would improve the smoothing and flattening of the paper product of Morgan as disclosed by Schonheit (col. 1, lines 6-15).

3) Claims 5-9, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haroldson (3,549,789). Haroldson discloses a polyamide paper product composed of aromatic polyamide fibers and fibrils (col. 1, lines 4-7). The structure of the paper is consolidated, shrunk, wherein the fibers and fibrils become contracted and firmly bonded causing the paper be more dense and thus of reduced pore structure (col. 2, line 49-75).

In the event any differences can be shown for the product of the product-by-process claim 5, as opposed to the product taught by the reference Haroldson, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

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4) Claims 1-2, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miyamoto (3,957,573).

Miyamoto discloses a process of making a paper from a slurry containing polyolefin fibers wherein the formed sheet is then frictionally calendered in a dry state of the paper web. The paper web undergoes a shearing force, where the calendered sheet is passed between two rolls rotating at different speeds (Abstract, col. 4. lines 5-28). It is inherent that the calendered sheet subjected to the frictional forces results in a glossy surface on the sheet, or in the least, it would have been obvious, to one skilled in the art at the time the invention was made, that the paper of Miyamoto would become glossy, since it is subjected to the same process under the same operating conditions as in the present invention.

***Allowable Subject Matter***

5) Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indicating allowable subject matter is that the cited prior art does not show a process for making a paper web having a glossy surface, the process using a calender wherein four calender rolls are used in a nested configuration

comprising of three large calender rolls surrounding a single smaller calender roll in the center of the three larger calender rolls (claim 4).

***Conclusion***

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 571-272-1190. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mark Halpern